

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

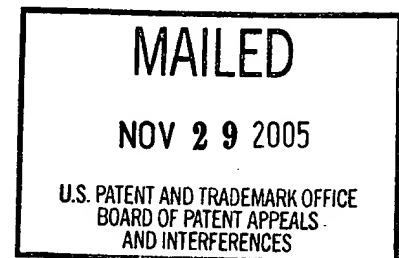
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte James Kargman, Marc Asher, David Brown and William Pallett

Appeal No. 2005-2748
Application No. 09/997,578

ON BRIEF



Before Krass, Barrett, and Barry, Administrative Patent Judges.

Krass, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-32.

The invention pertains to Internet commerce. In particular, a customer submits an order over the Internet to a business having a chain of stores and the order is input directly into the computerized ordering system of the closest, selected store, thereby bypassing the conventional manner of ordering through a live order-taker.

Representative independent claim 1 is reproduced as follows:

A method of receiving and placing an order on the Internet to a selected store of a chain of stores, comprising:

- (a) storing at an Internet web site at least a partial list of stores of a chain of stores, and their postal addresses, where each store of the at least a partial list of stores services customers in a specific geographical area;
- (b) storing at said Internet web site a postal-service listing of customers potentially serviced by said at least a partial list of stores;
- (c) creating the potentiality of establishing a point-to-point connection between the computer associated with said Internet web site with the associated computer of each of said at least a partial list of stores;
- (d) receiving a request to order at said Internet web site from a customer;
- (e) determining at said web site which store of said at least a partial list of stores services the customer of said step (d);
- (f) receiving the order from the customer of said step (d);
- (g) downloading the order received in said step (f) to the selected store from said step (e);
- (h) said step (g) comprising downloading the order directly into the computer system of the selected store, thereby bypassing the order-taking process of the selected store.

The examiner relies on the following reference:

Cupps et al. (Cupps)	5,991,739	Nov. 23, 1999
		(filed Nov. 24, 1997)

Claims 1-14, 16-24, 26-30, and 32 stand rejected under 35 U.S.C. §102 (b) as anticipated by Cupps.

Claims 15, 25, and 31 stand rejected under 35 U.S.C. §103 as unpatentable over Cupps.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Taking claim 1 as exemplary, the examiner identifies, at pages 3-4 of the answer, specific portions of Cupps which are said to correspond to the instant claimed steps.

Appellants' response is to concentrate on the claim language "downloading the order directly into the computer system of the selected store, thereby bypassing the order-taking process of the selected store."¹ It is appellants' position that Cupps requires an order taker at the recipient store in order to process the order.

¹Independent claim 16 has the same limitation, while independent claim 26 has a similar limitation.

While Cupps is mainly concerned with a voice instruction ordering system, column 12, lines 4-10, of the patent states:

In addition, the present invention is not constrained to transmitting a customer's order to the vendor through the interactive voice recognition system as described above. A modem connection can be established which will enable communication between the online ordering machine and the vendor through the Internet thereby allowing email communication, web communication, and the like.

It is this portion of the patent disclosure which is in contention, with the examiner employing this section to teach the disputed claim limitation step (h), and appellants arguing that no portion of Cupps expressly discloses the bypassing of a store order taking process and that no portion of Cupps makes the direct downloading of an order to bypass a store order taking process inherent.

We have reviewed the evidence before us, including the Cupps reference and the arguments of appellants and the examiner, and we find, as a result of such a review, that the examiner has established a prima facie case of anticipation which has not been successfully rebutted by appellants.

Accordingly, we will sustain the rejection of claims 1-14, 16-24, 26-30, and 32 under 35 U.S.C. §102 (b).

Contrary to appellants' assertions, we find that the cited portion of Cupps, wherein communication is established between an online ordering machine and a

vendor through the Internet, is strongly suggestive of “downloading the order directly into the computer system of the selected store, thereby bypassing the order-taking process of the selected store.” The whole reason for using the Internet to download the order to the vendor’s computer is to avoid the order-taking process at the store.

Appellants contend that mere communication of an order by web communication does not require that the order be directly downloaded into the store computer, bypassing the store order taking process. It is appellants’ contention that Cupps may be suggesting merely conveying an order electronically to an order-taker at the recipient store (principal brief-page 10).

It is our view that the very purpose of downloading an order to a store, as suggested by Cupps, is to avoid having to speak to an order-taker. By downloading the order, the order is right there in the vendor’s computer, ready to be filled by the appropriate personnel. To the extent that appellants argue this requires a human intervention (reply brief-page 4), it is our view that this differs not one bit from appellants’ invention, as disclosed and claimed. Eventually, down the line, there must be some human intervention to fulfill the downloaded order. Even appellants disclose that an order might be downloaded to a computer of a restaurant where the cook fulfills that order. We fail to understand how this is not a human intervention or how this does

not constitute “the attention of store personnel” (as argued by appellants at page 13 of the principal brief).

If it is a matter of *when* the human intervention occurs, i.e., at the order taking step or the fulfilling step, the instant claim language does not distinguish over that disclosed and suggested by Cupps. Appellants contend that the examiner has confused the steps of configuring an order by a customer, and conveying an order to a vendor's point-of-sale system (reply brief-pages 3-4). However, the claims make no distinction between “configuring” and “conveying.” The claims, e.g., claim 1, call for “downloading the order directly into the computer system of the selected store,” which the “communication between the online ordering machine and the vendor through the Internet,” recited at column 12, lines 8-9, of Cupps, clearly suggests. The claim further requires “thereby bypassing the order-taking process of the selected store.” By Cupps’ suggestion of downloading an order, through its teaching of a communication between computers of the customer and the vendor through the Internet, a compelling case is made for the bypassing of an order-taking process in Cupps. If Cupps is disclosing technology sophisticated enough to send an order over the Internet to a local store, which we believe the reference clearly suggests, the artisan would not take a step back from this disclosure, as appellants seem to be suggesting, and merely have an order-

taker copy the customer's order off the computer screen and then convey it manually to someone else in the business. Rather, the order is already in the store's computer system to be stored and/or displayed. Therefore, the person responsible for fulfilling the order would clearly do so from the computer instructions. It would be ludicrous, in our view, to merely have an order-taker in Cupps read off the order and convey that order to an order-fulfiller when Cupps' computer system is clearly designed to eliminate a separate order-taker by fulfilling the order directly from the computer information. For appellants to suggest otherwise is, in our view, unreasonable.

At page 4 of the reply brief, appellants again contend that their invention is entirely different from that described by Cupps in that their invention relates to a "different step of conveying an order, which has already been configured by a user online, to a vendor for fulfillment without further human intervention." Again, we note that the instant claims make no distinction between "conveying" and "configuring" nor are these terms recited in the claims. Moreover, we again note that this argument which recites "without further human intervention" is not persuasive because, somehow, at the end of the line, a human (e.g., the cook in an embodiment disclosed by appellants) will need to intervene to fulfill the order. We find no distinction between what is disclosed and clearly suggested by Cupps and the instant claimed subject matter.

Appellants assert that the description of electronically conveying the order in Cupps is limited to a single paragraph at the end of the specification and that this "limited description" (principal brief-page 9) fails to provide an enabling implementation even if one interpreted the disclosure to disclose a bypassing of the order-taking process (principal brief-page 10).

We disagree. The level of skill of one in the art of computers/networking is such, and was such at the time of the instant invention, that given the suggestion, by Cupps, of downloading an order to a store computer via the Internet, the artisan would clearly have been well aware of the techniques for actually doing so. Appellants have offered no evidence to show otherwise.

Again, at page 13 of the principal brief, appellants attempt to make a distinction about the instant invention not requiring human intervention, by stating that "contrary to Applicant's claimed invention, Cupps...clearly requires the attention of store personnel to process a faxed order." Whether an order is faxed, or sent over the Internet to a local store, it appears to us that appellants also require the attention of store personnel, at some point, to actually fulfill the transmitted order. We remain unconvinced of any distinction between the broadly claimed subject matter and that disclosed and clearly suggested by Cupps.

Accordingly, we will sustain the rejection of claims 1-14, 16-24, 26-30, and 32 under 35 U.S.C. §102 (b).

With regard to the rejection of claims 15, 25, and 31 under 35 U.S.C. §103, the examiner takes Official notice that it was well known in the delivery art to “normalize” addresses using address-normalization software and so it would have been obvious to normalize addresses by using address-normalization software “because this type of software is traditionally used in mail/delivery businesses to fulfill delivery compliance standards and to process deliveries faster and more efficiently” (answer-page 7).

Not only do appellants indicate, at page 4 of the instant specification, that such software was known and readily available, but appellants really don’t dispute this point, arguing, instead, that these claims include the limitation of downloading a customer order directly into the computer system of a selected store, thereby bypassing the order taking process of the selected store. Thus, appellants base their argument regarding the patentability of claims 15, 25 and 31 on the same arguments offered supra with regard to the other claims.

Since we are unpersuaded by this argument for the reasons supra, we will also sustain the rejection of claims 15, 25, and 31 under 35 U.S.C. §103.

The examiner’s decision, rejecting claims 1-14, 16-24, 26-30, and 32 under 35 U.S.C. §102 (b) and claims 15, 25, and 31 under 35 U.S.C. §103, is affirmed

AFFIRMED

~~Lance Leonard Barry
Administrative Patent Judge~~

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